

REMARKS

Through this Amendment, the Applicants amend claims 10, 23, 25-26, 29-30, 33 and 40-41. Claims 2-21, 23, 25-26, 29-30, 32-34 and 39-42 are pending in this Application. Applicants have carefully and thoughtfully considered the Office Action and the comments therein. Based on the foregoing amendment and the following remarks, it is respectfully submitted that the instant application is in condition for allowance. Prompt reconsideration and withdrawal of the rejections is earnestly requested.

Allowed Claims

On page 3 of the Office Action, in section 5, claims 2-9, 11-21 and 32 are allowed. Applicants thank the Examiner for allowing these claims.

Claim Objections

On page 2 of the Office Action, in section 3, claim 29 is objected to based on an informality. The Office Action suggests that the preamble of claim 29 be amended to recite "... financial strategy for asset to meet financial goals, *said computer system* comprising:" To further the prosecution of this Application, Applicants have accordingly amended claim 29. Withdrawal of the objection and allowance of claim 29 is respectfully requested.

Rejections under 35 U.S.C. § 101

On pages 2-3 of the Office Action, in section 4, claims 10, 23, 25-26, 30, 33, 39, 40 and 41 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Applicants respectfully traverse these rejections.

On page 2, the Office Action rejects claim 25, stating that “claiming a program per se is not in any statutory category.” Applicants respectfully disagree, as claim 25 is directed to a computer-readable medium, not a program per se. However, to expedite the prosecution of this Application, claim 25 has been amended to be placed in an independent form and to recite “a computer-readable medium having computer-executable instructions ...” Further, for similar reasons as discussed below with reference to claims 30 and 34, claim 25 is respectfully submitted as allowable.

On page 2 of the Office Action, claims 10, 23 and 40-41 are rejected as crossing over more than one statutory class. Claims 10, 23 and 40-41 are directed to a method and are dependent on claim 2. Claim 2 is directed to a “computer-implemented method.” Thus, claims 2, 10, 23 and 40-41 are all directed to a process, which is a statutory category under 35 U.S.C. § 101. *See MPEP 706.03(a)*. The recitation of “computer-implemented” in claim 2 does not place claim 2 in a different statutory class from claims 10, 23 and 40-41. Also, it is clear that the method of claims 10, 23 and 40-41 refer back to the computer-implemented method of claim 2. Thus, Applicants respectfully disagree with the Office Action that claims 10, 23 and 40-41 cross over more than one statutory class.

Nonetheless, in order to expedite the prosecution of this application, claims 10, 23 and 40-41 have been amended to recite “A computer-implemented method according to claim 2 ...” It is believed that this amendment will overcome these rejections. Accordingly, withdrawal of the rejection of claims 10, 23 and 40-41 and allowance thereof is respectfully requested.

Claims 26 and 33 have also been rejected as crossing over more than one statutory class. Claim 26 has been amended herein to be placed in an independent form. Claim 33 has been amended to depend on claim 26. Accordingly, claims 26 and 33 are now directed to a system

and do not include more than one statutory class. Withdrawal of the rejection of claims 26 and 33 and allowance thereof is respectfully requested.

On page 3 of the Office Action, claims 30 and 34 have been rejected as being non-statutory. Specifically, the Office Action asserts that it is unclear whether the computer-readable medium is a storage medium and “the body of the claim merely represents limitations that may not necessarily be executed by the system.” The Office Action further asserts that “[m]erely storing data without some kind of transformation of data is non-statutory.” Applicants respectfully disagree and submit these claims as allowable.

The four enumerated categories of statutory subject matter under 35 U.S.C. § 101 include “any new and useful process, machine, manufacture, or composition of matter, or any new or useful combination thereof.” In the instant application, claims 30 and 34 are directed to a computer-readable medium. As discussed in the last paragraph of page 7 of the Specification, and as amended in the Amendment and Response filed September 20, 2007, “[a] ‘computer-readable medium’ refers to **any storage device used for storing data** accessible by a computer. Example of a computer-readable medium include: a magnetic hard disk; a floppy disk; an optical disk, such as a CD-ROM; a magnetic tape; and a memory chip” (emphasis added). Thus, the recitation of “computer-readable medium” in the claims should be read in light of its discussion as provided in the Specification, which establishes that the claimed computer-readable medium is in fact a computer-readable **storage** medium. Such storage medium is an article of manufacture and within the enumerated categories of statutory subject matter under 35 U.S.C. § 101.

Applicants respectfully disagree with the assertion of the Office Action that “the body of the claim merely represents limitations that may not necessarily be executed by the system.” To

clarify the invention, claim 30 has been amended to recite “A computer-readable medium having ***computer-executable instructions*** for determining at least one financial strategy for assets to meet financial goals” (emphasis added). As such, the recited instructions are computer executable. Accordingly, it is respectfully submitted that claims 30 and 34 are directed to statutory subject matter.

In addition, contrary to the assertion by the Office Action, the recited computer-executable instructions of claims 30 and 34 are **not** “[m]erely storing data without some kind of transformation of data.” The recited computer-executable instructions receive investor financial preferences, perform a plurality of Monte Carlo simulations, generate rates of return, determine financial projections for each financial strategy, determine attribute measures for each financial strategy, determine a utility score for each financial strategy, and select at least one financial strategy based on the utility score. These computer-executable instructions transform data and do **not** merely store data. Thus, claims 30 and 34 recite statutory subject matter.

Further, as set forth in MPEP 2106.01, functional descriptive material recorded on a computer-readable medium becomes structurally and functionally interrelated to the medium and will be statutory since use of technology permits the function of the descriptive material to be realized. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Here, the recited “computer-executable instructions” are “functional descriptive material” as they impart functionality when employed as a computer component. *See MPEP 2106.01*. The features of claims 30 and 34 are functionally descriptive and are not directed to functionally non-descriptive material such as music, literary work, and mere compilation of data. Thus, the recited computer-readable medium is statutory subject matter.

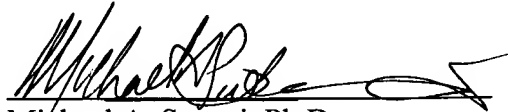
Moreover, in *In re Beauregard*, 53 F.3d 1583, 35 USPQ2d 1381 (Fed. Cir. 1995), claims recited in a computer-readable medium format were determined by the Office to be statutory subject matter. In that case, the Examiner rejected claims directed to computer programs embodied in a tangible medium, and the Board of Patent Appeals and Interferences affirmed the Examiner's rejection. During the appeal process, however, the Office reversed its position and stated that "computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101." *Id. at 1584*. Although claims 30 and 34 do not follow the specific format of the *Beauregard* claims, they do recite a computer-readable medium having computer-executable instructions. Thus, claims 30 and 34 are directed to statutory subject matter under 35 U.S.C. § 101. Therefore, withdrawal of the rejection of claims 30 and 34 and allowance thereof is respectfully requested.

Claim 39 appears to have been inadvertently rejected. Claim 39 recites "A computer-implemented method according to claim 2" and is not directed to a computer-readable medium. Accordingly, withdrawal of claim 39 and allowance thereof is respectfully requested.

THEREFORE, because all rejections have been overcome, it is submitted that claims 2-21, 23, 25-26, 29-30, 32-34 and 39-42 are allowable and such allowance is requested.

Respectfully submitted,

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